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Attorney's Docket No. 002964.P012

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:
Joe G. Naylor, et al.
Serial No.: 09/187,332
Filed: November 6, 1998
For: **ONE-TOUCH SYSTEM FOR SENDING ELECTRONIC MAIL AND FACSIMILES FROM A FAX MACHINE- UTILITY**

Examiner: Harrell, Robert B.
Art Unit: 2142

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22314-1450

Dear Sir:

Appellants submit, in triplicate, the following Appeal Brief pursuant to 37 C.F.R. §1.192 for consideration by the Board of Patent Appeals and Interferences. Appellants also submit herewith a check in the amount of $165.00 to cover the cost of filing the opening brief as required by 37 C.F.R. §1.17(c). Please change any additional amount due or credit any overpayment to the Deposit Account 02-2666.

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I. REAL PARTY IN INTEREST

The real party in interest is the assignee, j2 Global Communications, Inc. of Hollywood, California.

II. RELATED APPEALS AND INTERFERENCES

Appellants know of no other related appeals or interferences.

III. STATUS OF THE CLAIMS

Claims 19-36 are pending and are the claims on appeal. Claims 1-18 have been canceled and form no part of this appeal.

IV. STATUS OF THE AMENDMENTS

No amendment has been filed subsequent to the final rejection in the Office Action dated October 20, 2003.

V. SUMMARY OF INVENTION

In many instances it may be desirable for a party to send both faxes and electronic mail to a recipient. Such is the case, for instance, when getting a message to a person is very important. Sometimes receiving fax machines will run out of paper, become jammed or in some other way become inoperative. They will remain so until serviced by someone on the receiving end who becomes aware of the fax machine's inoperative state. Furthermore, a fax machine is generally unattended and received documents may well sit in the fax machine until someone discovers them much after they have been transmitted and received. In large companies it often takes a long time for a received fax to get to the intended recipient. An incoming fax will come into a centralized fax machine and be routed through the company's mail room. As a result it may take several days for the document to be delivered to the intended receiving party.

Although faxing information has its drawbacks, transmission by electronic mail has its own disadvantages. In most cases electronic mail will not be received until the recipient decides to check his e-mail. This usually involves logging into the appropriate

software program to receive the mail. Some people do not check their e-mail for days or even weeks, if ever. Therefore, the intended recipient of the e-mail may not see it for a very long time, or the document may never be viewed by the intended recipient at all.

Sending both faxes and electronic mail to a recipient is therefore desirable to increase the odds of timely receipt of information. However, in the past this has normally required that the sender place the document into a fax machine, enter the recipient(s) fax telephone number into the fax device, and then transmit the document via facsimile. The sender would then have to prepare the document in electronic mail format on a computer, enter appropriate e-mail addresses and then transmit the document via electronic mail. This process of entering the same data into two devices is very time-consuming and therefore expensive.

Furthermore, although personal computers equipped with fax modems have been used in the past to send both faxes and e-mails, such operations are not always easy and often require specialized software for both e-mail and fax functions and knowledge thereof. Additionally, using a computer to send both electronic mail and faxes typically requires that the user import data and operate separate fax and e-mail software programs to transmit a document both by fax and by e-mail. [See original patent application as filed, page 2, line 12 through page 3, line 22.]

An embodiment of the invention is directed to a method in which both a facsimile telephone number and an electronic mail address of the same recipient is received from a user, and stored in the memory of a facsimile machine. A document provided by the user to the facsimile machine is converted into digital form. An actuator disposed on the facsimile machine is associated to locations in memory which contain the telephone number and the electronic mail address. This converted document is transmitted to the facsimile telephone number and to the electronic mail address, in response to the same instance of the actuator being activated by the user. [See original patent application as filed, page 4, line 12 through page 5, line 2.]

In such a method, a user can advantageously (with increased confidence in the recipient receiving the message) send both a fax and an e-mail to the same recipient,

without having to use both a facsimile machine and a personal computer. In addition, time can be saved when the fax and e-mail are sent in response to a single command from the user. [See original patent application as filed, page 4, lines 1-7.]

VI. ISSUES

The issues are whether claims 19-36 are obvious in view of the relied upon art references of U.S. Patent No. 5,805,289 issued to Ho, et al. ("Ho") in view of U.S. Patent No. 5,870,089 issued to Fabbio, et al. ("Fabbio").

VII. GROUPING OF THE CLAIMS

All of claims 19-36 do not stand or fall together. Rather, they are grouped as follows:

Group I : Claims 19-21, 23, 26-28, 30-34, and 36
Group II : Claim 22, 24-25, 29, and 35

The Argument section below will explain why the groups are believed to be separately patentable.

VIII. BRIEF DESCRIPTION OF THE ART REFERENCES

In Ho, a communications device is configured to send a scanned document to a specified destination which can be either a remote fax machine or an e-mail address, in response to a Send button being pressed by the user. Ho, Figure 2A and Figure 3, and column 6 lines 24-56. The device in Ho gives the user an opportunity to enter a single destination identifier, for the document to be transmitted by a single application of the Send button. Ho, column 6 lines 24-38.

Turning now to Fabbio, this reference is directed to the use of a data structure in distributing documents to various resources accessible by a computer or a network of computers. A software construct or metaphor for an electronic package is provided, where the electronic package encapsulates the message and information about multiple destinations. Fabbio describes a software system for a group of networked computers, to allow a document to be sent from a general purpose computer and network on which the software system will be running.

VIX. THE REJECTIONS

Claims 19-36 stand rejected as being obvious in view of the combination teachings of Ho and Fabbio. While Ho does not specifically send its message via both facsimile and e-mail "at the same time", such would allegedly have been obvious. In essence, according to the rejection, since the Ho device could do both tasks, doing both at different times or at the same time would have been obvious. To support that contention, the rejection relies on Fabbio as teaching the sending of e-mail and fax "at the same time". In addition, the rejection continues with the argument that since Ho calls for a local area network (LAN) version, and Fabbio also teaches a LAN version, it would have been obvious to use Fabbio's system in Ho's system, specifically, delivery server 12 in Figure 2 of Fabbio for the PSTN 106 in Figure 1 of Ho.

To support the rejection of dependent claim 22, the Examiner stated that since the PSTN is a public switched telephone network "having several computers", and Fabbio teaches that the delivery server 12 (Figure 2) is a server, then claim 22 is obvious because in Ho the e-mail is sent via a server and the facsimile is sent via the PSTN 106.

X. ARGUMENT

Arguments Directed to the Claims of Group I

The rejection appears to set forth the Examiner's reasoning that in view of Ho alone, it would have been obvious to transmit a message via the fax communication lines while at the same time transmitting corresponding e-mail via the e-mail communication lines, by modifying Ho to allow the user to enter not only one but both fax and e-mail information. Appellant here assumes that the Examiner is not taking the position that Ho by itself can be used to reject the claims, but rather it is in combination with Fabbio. This is significant, because the communications device 100 in Ho sends a scanned document to a specified destination, which can be **either** a remote facsimile machine or an e-mail address, in response to a Send button being pressed by the user. Ho, Figures 2A and 3, column 6, lines 24-56. ("A user wishing to transmit a document via the communications device positions the document appropriately in the scanner 204, presses the Start button, enters a destination identifier via the keyboard 206 and presses the Send button. If the document is to be sent to a remote facsimile machine,

then the destination identification is in the form of a telephone number ... if the document is to be sent to a remote electronic mail box then the destination identification is in the form of an Internet electronic mail address ...") In other words, only one opportunity is provided for the user to enter a **single** destination identifier, for a document to be transmitted by a **single** application of the Send button. This, therefore, does not teach or suggest receiving from the user a facsimile telephone number **and** an electronic e-mail address **of the same recipient**, and transmitting a converted document to **both** the facsimile telephone number and the e-mail address in response to the same instance of an actuator being activated by the user (see Appellants' claim 19).

The Examiner's position is that it would have been obvious to modify Ho so that the converted document is sent to both a facsimile telephone number and an e-mail address simultaneously at the push of a button, because that is simply an obvious thing to do. In other words, if the document can be sent by facsimile and it can be sent by e-mail, then it allegedly can obviously be sent simultaneously. Appellants, of course, respectfully disagree with this conclusion as being entirely based hindsight. As mentioned above, in many instances it is desirable for a party to send both a fax and an e-mail to the same recipient, because it may increase the odds of timely receipt of information. Ho suggests no such concern. In addition, the modification needed to the communications device of Ho is also not taught or suggested by the other reference relied upon by the Examiner, namely Fabbio.

As introduced above, Fabbio is directed to a software construct or metaphor for encapsulating information about how a package is to be delivered, by a computer system. To send a document to, for example, an e-mail address and a facsimile machine at the same time, the user first creates an electronic package data structure, as well as references to each of the destinations. After creating this structure the user communicates it to the data delivery service system 12, and this system then performs the operations necessary to deliver the document to the different destinations at the same time. (Fabbio, column 3, lines 4-22) (See also Fabbio, Summary of the Invention, column 2, lines 26-37) ("More particularly, it is an object of the invention to provide a system and method for producing a data structure used in distributing documents to

various resources accessible by a computer or a network of computers. Another object of the invention is to provide a method and apparatus for creating a construct or metaphor for an electronic package. A further object of the invention is to provide a system and method for distributing the information to numerous different types of destinations accessible by a computer or network of computers.")

In repeating the teachings of Fabbio, Appellants' point here is that one of ordinary skill in the art who is concerned with improving the value of a **facsimile machine** as a stand alone, document transmission device, to deliver a message **more reliably to the recipient**, would not look to learn from the general purpose computer software system of Fabbio. First, as is clear from the Background section of Fabbio, the problem being addressed there is that of too many software components in a personal computer, to deliver a document to both a facsimile machine and a printer, for example. (Fabbio, column 1, line 65 through column 2, line 12) ("Thus, generally each time a user wanted to send a document or information to a particular destination or resource, the user had to separately run the particular software that controlled the transmission process or resource. Also, the delivery of a particular document to a certain destination often required changing the format of the document to a format acceptable to the destination. **This process of separately running multiple software products to transmit information to various destinations was time consuming and required that the user have knowledge of the software controlling each transmission or resource.**") [Emphasis added]

Second, in Fabbio, the data structure is designed to allow different destinations to be identified on a graphical user interface for sending a digital document. But, there is no suggestion that these destination identifiers be **of the same recipient**. Indeed, as can be seen in Figure 7 of Fabbio, this graphical user interface provides that the new package can be associated with a facsimile machine as a destination, and an e-mail box as a destination, but does not suggest that these two destinations are for the same recipient. This is an important point, because Appellants' claimed method is directed to a facsimile machine receiving from the user a telephone number and an e-mail address of the same recipient and transmitting the converted document to the telephone number and e-mail address in response to the same instance of the actuator being

activated by the user. Thus, this claim not only recites transmitting a facsimile to a recipient, but also gives the user additional confidence that the recipient will receive the information in the facsimile by an e-mail confirmation, all with the single activation of an actuator on the facsimile machine. Such a beneficial result is not contemplated in Fabbio.

The reasoning provided by the Examiner in finding that it would have been obvious to use the teachings of Fabbio to modify Ho is flawed for the following additional reason. The Examiner states that because Ho mentions a local area network (LAN) version, and Fabbio also teaches a LAN version, it would have been obvious to use the Fabbio teachings to modify Ho's system. This reasoning, however, presents an incorrect analogy, namely that delivery server 12 in Fabbio's Figure 2 may be used in place of the PSTN 106 in Figure 1 of Ho. This analogy is not reasonable, because it attempts to replace a public switched telephone network with the functionality of a delivery server 12, namely, in this case, software running in a computer system or network.

Moreover, in both Ho and Fabbio, the connections to transmit an e-mail version of a document may include a LAN. That, however, is not enough to suggest to one of ordinary skill in the art that Ho be modified to allow its user to enter two different types of destinations, for the same document and the same recipient. With all due respect, the Examiner is improperly attempting to support the obviousness argument based on a merely tangential similarity between the two references, namely that both refer to the use of a LAN as an intermediate path to transmit an e-mail.

Arguments Directed to the Claims of Group II

The claims in Group II are all dependent claims which depend on their base claims within Group I. These dependent claims further recite the capability that the converted document be transmitted to a server, where the server then transmits the converted documents to the facsimile telephone number via the PSTN and to the electronic mail address via a package switched data network (claim 22). Alternatively, Group II may be viewed as a system in which a computer program has binary file transfer (BFT) capability for transmitting a facsimile version and an e-mail version of

the document to a server (claim 29). Yet another alternative, is to consider Group II as directed to a computer readable memory having a sub-module for formatting message data derived from a scanned version of the document, appending standard fax formatting information and user specified information (including the facsimile telephone number and e-mail address) to the formatted message data, and transferring this formatted message data with the appended information to a server (claim 35). As explained below, the combination of Ho and Fabbio does not teach or suggest any one of these capabilities which involve a server for transmitting the document to both the facsimile telephone number and the e-mail server.

The use of Appellants' claimed server as an intermediary allows the transmission from the facsimile machine, of the e-mail and the fax message, to be in accordance with just a single protocol. According to the rejection, this would have been an obvious modification to Ho, because in Ho the e-mail is sent via the PSTN 106, which "having several computers" would be analogous to the delivery server 12 of Fabbio (being a server). This reasoning, however, is flawed because it does not articulate a reason or motivation for making such a change. There is no concern in either Ho or Fabbio that an intermediary server be used, between the facsimile machine from which the facsimile and e-mail versions of the message originate, and their destinations. Even if the delivery server 12 of Fabbio were capable of both fax and e-mail protocol transmissions, this is only in the context of a computer system from which a document originates; this does not suggest that delivery server 12 be used as an intermediary server, between a facsimile machine from which a document originates and its ultimate destination.

XI. CONCLUSION AND RELIEF

Based on the foregoing, Appellants request that the Board overturn the Examiner's rejection of all pending claims and hold that all of the claims of the present application are allowable.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Dated: March 26, 2004.

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CERTIFICATE OF MAILING

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Marguax Rodriguez *March 26, 2004*

XII. APPENDIX A

The claims involved in this Appeal are as follows:

19. (Previously Presented) A method comprising:

receiving from a user a facsimile telephone number and an electronic mail address of the same recipient, and storing the number and address in a memory of a facsimile machine;

converting a document provided by the user to the facsimile machine into digital form;

associating an actuator disposed on the facsimile machine to locations in the memory which contain the facsimile telephone number and the electronic mail address; and

transmitting the converted document to the facsimile telephone number and to the electronic mail address in response to the same instance of the actuator being activated by the user.

20. (Previously Presented) The method of claim 19 wherein the converted document is transmitted in response to a button, which is disposed on the facsimile machine, being pushed by the user.

21. (Previously Presented) The method of claim 19 wherein the converted document is transmitted to a server, which can access at least one of the facsimile telephone number and the electronic mail address.

22. (Previously Presented) The method of claim 21 further comprising the server transmitting the converted document to the facsimile telephone number via a public switched telephone network (PSTN), and to the electronic mail address via a packet switched data network.

23. (Previously Presented) The method of claim 21 wherein the document is converted by scanning the document.

24. (Previously Presented) The method of claim 23 further comprising:

formatting message data derived from the scanned document; and

appending standard facsimile formatting information, and user-specified information comprising the facsimile telephone number and the electronic mail address, to the formatted message data,

wherein the converted document is transmitted by transmitting the formatted message data and appended information to the server.

25. (Previously Presented) The method of claim 24 further comprising the steps of the server:

receiving the appended information and message data from the facsimile machine;

extracting the facsimile telephone number from the user-specified information;

transmitting the message data with the facsimile formatting data to a facsimile device associated with the facsimile telephone number;

extracting the electronic mail address from the user-specified information;

stripping the appended information from the message data;

applying a standard electronic mail header to the message data; and,

transmitting the message data with its applied electronic mail header to an electronic mail mailbox associated with the electronic mail address extracted from the user-specified information.

26. (Previously Presented) The method of claim 19 wherein the converted document is transmitted via a PSTN connection in the facsimile machine.

27. (Previously Presented) A system comprising:

a computing device resident in a facsimile machine; and

a computer program comprising program modules executable by the computing device, wherein the computing device is directed by the computer program modules to

store a facsimile telephone number and electronic mail address corresponding to a same recipient in a memory location in a memory of the facsimile machine, said number and address having been previously entered by a user into the facsimile machine,

associate an actuator disposed on the facsimile machine to the memory location containing the facsimile telephone number and electronic mail address, and

transmit a facsimile of a document placed into the system by the user to the facsimile telephone number, and an electronic mail version of the document to the electronic mail address, in response to the same activation of the actuator by the user.--

28. (Previously Presented) The system of claim 27 wherein the actuator includes a button.

29. (Previously Presented) The system of claim 27 wherein the computer program includes binary file transfer (BFT) capability for transmitting a facsimile version and an electronic mail version of the document to a server.

30. (Previously Presented) The system of claim 27 wherein the computer program includes facsimile communication protocol capability for transmitting a facsimile version of the document directly via a PSTN connection in the facsimile machine.

31. (Previously Presented) The system of claim 30 wherein the computer program includes e-mail communication protocol capability for transmitting an electronic mail version of the document.

32. (Previously Presented) A computer-readable memory for sending electronic mail and facsimiles from a facsimile machine, comprising:

a computer-readable storage medium; and

a computer program stored in the storage medium, wherein the storage medium is so configured by the computer program that it causes a computing device resident in a facsimile machine to

store a facsimile telephone number and electronic mail address corresponding to a same recipient in a memory location in a memory of the facsimile machine, said number and address having been previously entered by a user,

associate an actuator disposed on the facsimile machine to the memory location containing the facsimile telephone number and electronic mail address, and

transmit a facsimile of a document placed into the facsimile machine by the user to the facsimile telephone number, and an electronic mail version of the document to

the electronic mail address, in response to the same activation of the actuator by the user.

33. (Previously Presented) The computer-readable memory of claim 32, wherein the program comprises a sub-module for transmitting at least one of (i) the facsimile and (ii) the electronic mail to the recipient via a server.

34. (Previously Presented) The computer-readable memory of claim 33, wherein the sub-module for transmitting via the server comprises means for transmitting the electronic mail and not the facsimile via the server, and means for transmitting the facsimile directly to the recipient via a PSTN connection.

35. (Previously Presented) The computer-readable memory of claim 33, wherein the sub-module comprises sub-modules for:

formatting message data derived from a scanned version of the document;

appending standard facsimile formatting information, and user-specified information comprising the facsimile telephone number and the electronic mail address, to the formatted message data; and

transferring the formatted message data and appended information to the server.

36. (Previously Presented) The computer-readable memory of claim 32 wherein the program comprises sub-modules for:

sending the facsimile via a PSTN connection in the facsimile machine; and sending the electronic mail via a connection in the facsimile machine to a wide area network.